

REMARKS

By an Office Action dated April 21, 2005 in the file of the above-identified application, the applicant makes the response contained herein.

First, the text of claims as presented herein with the text of Claim 49 omitted, so that no canceled claims are provided in the complete listing of the claims.

There is only one grounds of substantive rejection in the Office Action. This is a rejection under 35 U.S.C. §102(e) as anticipated by Quate U.S. Patent No. 6,480,324, having a priority date of 29 May 1998. The Examiner has put the applicant on notice that the applicant must comply with the requirements of 37 C.F.R. §41.202(b) before an interference with the Quate patent will be declared. This document is intended to meet the requirements of 37 C.F.R. §41.202 so that an interference may proceed.

First, it is believed that the test the applicant must meet is 37 C.F.R. §41.202(a) since the applicant here is an application and the Quate patent is a patent. The applicant will proceed on that basis. Each of the requirements of the section will be delineated below.

Suggestion of Interference

The applicant of the above-identified application hereby suggests an interference with Quate U.S. Patent No. 6,480,324. It is believe this suggestion complies with the provisions of §41.202(a)(1).

Suggestion of Count

The applicant believes that the proper count for this interference should be Claim 39 as it existed before the amendment made by the applicant on May 17, 2004. Thus the count would read as follows:

“39. An apparatus for catalyzing a reaction on a substrate comprising:
a light source;
a computer-controlled micromirror positioned to redirect light from the light source toward the substrate; and
a reaction chamber, wherein light redirected by the micromirror catalyzes a chemical reaction proximate the substrate in the reaction.”

The applicant asserts that all of the claims of U.S. Patent No. 6,480,324 correspond to this count, and no claims of the patent are patentably distinct from this count.

Claim Chart to Patent

In compliance with the requirements of Rule 41.202(a)(3), a claim chart comparing Claim 39 of this application and the disclosure of Quate U.S. Patent 6,480,324 is attached hereto in compliance with this provision.

Evidence of Priority

The next requirement in the rule, §41.202(a)(4) requires the applicant to explain in detail why the applicant will prevail on priority. This is understood to be a similar requirement to the prior Rule 608, which requires the applicant to make a *prima facie* case of why it will prevail on priority, so that an interference will be declared.

Enclosed with this submission is another copy of a Declaration Under 37 C.F.R. §1.131, already submitted in the file of this application and executed by the inventor thereof Harold R. Garner. This Declaration, although submitted for another purpose, is still evidence in the file of this application. The evidence in this Declaration may be considered for the present purpose and contains sufficient information to establish reduction to practice of the invention prior to the filing date of the Quate application. In particular, attached to the Declaration of Garner is an annotated photograph, designated Exhibit B to that Affidavit. Inventor Garner testifies that the photograph was taken in August of 1997.

The photograph contains all elements of the count. In the left-hand portion of the photograph as Exhibit B is a UV light source which meets the requirement of Claim 39 that there be an ultraviolet light source in the claimed apparatus. Further, in the photograph marked Exhibit B there is a "DLP" connected to a DLP driver board and a DLP power supply. DLP refers to a digital light programming device which is the same thing as the "computer controlled micromirror position to redirect light from the light source toward the substrate" as presently recited in Claim 39 of this patent application. Also shown in the photograph in Exhibit B is a "reaction chamber mount" containing the reaction chamber, which is the same thing as the element recited in Claim 39 of "a reaction chamber, wherein light redirected by the micromirror catalyzes a chemical reaction proximate the substrate in the reaction." The substrate reaction is contained within the reaction chamber in the reaction chamber mount and the successful catalysis of the reaction is demonstrated by the chemistry of the successful run which is contained in Exhibit C3 attached to the Declaration by inventor Garner.

In order to prevail on priority at least some collaboration of the testimony of the inventor is required. Attached herewith is a Declaration of John Fondon who was at that time a student in the laboratory of Dr. Garner. Dr. Fondon, now a professor at the University of Texas Southwestern, testifies in his Declaration that he saw the device in the photograph attached to Dr. Garner's Declaration, and he saw that actual physical device in November of 1997, all well before the filing date of the patent application by Quate. It is believed that this evidence by the inventor corroborated by the testimony of John Fondon makes a *prima facie* case of priority which will establish this invention being made prior to the filing date of the Quate application. Note that the dates referred to in the Declaration by Garner and in the corroboration by Fondon are all in 1997, and the priority date claimed by the Quate application is May 29, 1998.

Second Claim Chart

The next requirement of Rule 41.202(a)(5) is that if a claim has been added or amended to provoke the interference providing a claim chart showing the written description for each claim in the applicant's specification. While the applicant believes it has not specifically amended its claims for the purpose of the interference, nevertheless, out of an abundance of caution, the applicant presents herewith yet another claim chart showing how the claims of the present application are supported by the specification of this application, using the published version of this application as U.S. Published Application No. 20020041420. Thus while this provision is not believed to be applicable here, out an abundance of caution the applicant has met it anyway.

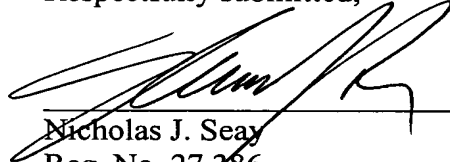
Constructive Reduction to Practice

Section 41.202(A)(6) requires that for each constructive reduction to practice for which the applicant wishes to be accorded benefit, that the applicant file a claim chart showing where the disclosure provides constructive reduction to practice. The applicant here does not rely on any constructive reduction to practice prior to its effective filing date of June 4, 1998.

Wherefore it is believed that the applicant has thereby successfully met the requirements of 37 C.F.R. §41.202(a) and the applicant has made a showing that it can make a *prima facie* case to prevail on priority, and accordingly the declaration of an interference with Quate U.S. Patent No. 6,480,324 is respectfully requested.

A separate Petition for Extension of Time is submitted herewith so that this response is considered as timely filed. Please charge the extension fee and any other fee due to Deposit Account No. 17-0055.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Nicholas J. Seay', is written over a horizontal line.

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DIGITAL OPTICAL CHEMISTRY MICROMIRROR IMAGER



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Serial No.: 09/998,341

Filed: 11/29/2001

Group Art Unit: 1634

Examiner: B. Forman

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U.S. Serial No.: 09/998,341	U.S. Patent No. 6,480,324 (Quate Apparatus)
<p>39. An apparatus for catalyzing a reaction on a substrate comprising:</p> <p>a ultraviolet light source;</p> <p>a computer-controlled micromirror positioned to redirect light from the light source toward the substrate; and</p> <p>a reaction chamber, wherein light redirected by the micromirror catalyzes a chemical reaction proximate the substrate in the reaction.</p>	<p>The '324 patent describes a optical lithography system including computer generated electronic control signals and a spatial light modulator, without any photomask, to project a predetermined light pattern onto a surface of a substrate for the purposes of deprotecting various areas of a polymer array. (Col. 2, lines 26-34).</p> <p>The apparatus includes a UV light source with a bandpass wavelength of 365-410 nm (see, for example, Col. 4, lines 52-54; Col. 6, lines 58-65; Col. 7, lines 42-60; and Claim 1, 1st element).</p> <p>The apparatus provides for a "programmable micro-mirror used for photolithographic synthesis," where the computer controlled mirrors project "predetermined light patterns" on a substrate. (see, for example, Fig. 1 and 2, Col. 2, lines 26-33 and 41-52; Col. 3, lines 45-53 and 58-63; Col. 4, lines 2-5, lines 22-40; Col. 7, lines 62-67; Claim 1, 3rd element and Claim 8).</p> <p>The substrate holder or the microarray reaction sites, on which the chemical reaction is performed. (see, for example, Col. 5, lines 38-42; Col. 6, lines 3-8, Claim 10)</p>